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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/784,655	02/23/2004	Volker Hildebrand	18894/04911 (GT-1007)	2354

24024 7590 08/10/2006

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EXAMINER

MAKI, STEVEN D

ART UNIT PAPER NUMBER

1733

DATE MAILED: 08/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/784,655	<b>Applicant(s)</b> HILDEBRAND, VOLKER	
	<b>Examiner</b> Steven D. Maki	<b>Art Unit</b> 1733	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 May 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-27 and 29-33 is/are rejected.
- 7) ☒ Claim(s) 28 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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1) Claim 31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 31, "curves" on the last line should be --grooves--. This suggested change will clarify the acute angle at which the sipes are arranged; it being noted that there is antecedent basis for "the circumferential grooves" but not --the circumferential curves--.

2) The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Mirtain et al

3) **Claims 1-8 and 10-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mirtain et al (US 4387754) in view of Hitzky (US 5381816), Japan 105 (JP 63-159105) and Japan 703 (JP 58-177703).**

Mirtain et al, Hitzky, Japan 105 and Japan 703 are applied as in paragraph 5 of the last office action (paragraph 5 of the last office action is incorporated herein by reference).

Applicant argues that Mirtain et al does not describe "... a tire tread in which none of the lateral grooves in the inner and outer shoulders reaches the corresponding inner or outer circumferential groove, as now expressly claimed." (page 11 of response filed

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5-24-06). This argument is not persuasive since claim 1 requires "the inner shoulder rib having inner lateral grooves, each inner lateral groove extending from the inner shoulder toward but not reaching the inner circumferential groove, ... the outer shoulder rib having outer lateral grooves, each outer lateral groove extending from the outer shoulder toward but not reaching the outer circumferential groove" (emphasis added) **instead of** "... a tire tread in which none of the lateral grooves in the inner and outer shoulders reaches the corresponding inner or outer circumferential groove" (emphasis added). In other words, claim 1 reads on and fails to exclude lateral grooves extending from the circumferential groove but not reaching the shoulder. Only lateral grooves that extend from the shoulder are required to not reach the circumferential groove. Claim 1 fails to exclude both types of lateral grooves in Mirtain et al's shoulder rib.

4) **Claims 32 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mirtain et al in view of Hitzky, Japan 105 and Japan 703 as applied above and further in view of Landers (US 4474223).**

Landers is applied as in paragraph 6 of the last office action (paragraph 6 of the last office action is incorporated herein by reference).

Japan 913 (curved sipes intersecting circumferential grooves)

5) **Claims 1-11, 19, 23-25 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Japan 913 in view of in view of Hitzky, Japan 105 and Japan 703 .**

Japan 913, Hitzky, Japan 105 and Japan 703 are applied as in paragraph 7 of the last office action (paragraph 7 of the last office action is incorporated herein by reference).

Applicant argues that Japan 913 does not describe "... a tire tread in which none of the lateral grooves in the inner and outer shoulders reaches the corresponding inner or outer circumferential groove, as now expressly claimed." (page 11 of response filed 5-24-06). This argument is not persuasive since claim 1 requires "the inner shoulder rib having inner lateral grooves, each inner lateral groove extending from the inner shoulder toward but not reaching the inner circumferential groove, ... the outer shoulder rib having outer lateral grooves, each outer lateral groove extending from the outer shoulder toward but not reaching the outer circumferential groove" (emphasis added) **instead of** "... a tire tread in which none of the lateral grooves in the inner and outer shoulders reaches the corresponding inner or outer circumferential groove" (emphasis added). In other words, claim 1 reads on and fails to exclude lateral grooves extending from the circumferential groove but not reaching the shoulder. Only lateral grooves that extend from the shoulder are required to not reach the circumferential groove. Claim 1 fails to exclude both types of lateral grooves in Japan 913's shoulder rib.

Lopez (pair of oppositely curved sipes)

6) **Claims 1-11, 17-27, 29 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lopez 652 (US Des. 462,652) in view of in view of Hitzky, Japan 105 and Japan 703 and optionally Lopez 552 (US 6874552).**

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Lopez 652, Hitzky, Japan 105, Japan 703 and the optional Lopez 552 are applied as in paragraph 8 of the last office action (paragraph 8 of the last office action is incorporated herein by reference).

Applicant argues and examiner agrees that Lopez 652 is a design patent. Examiner adds that one of ordinary skill in the art would have been motivated to incorporate Lopez 652's tread design in a pneumatic tire so as to obtain the self evident benefit of a pneumatic tire having the ornamental design of Lopez 652. One of ordinary skill in the art would readily recognize that if Lopez 652's ornamental design of a tread for a tire is not incorporated into an actual tire, the benefits of Lopez 652's ornamental tread design would essentially be lost.

Applicant argues one of ordinary skill in the art would have started with a tire design which exhibited good traction on dry or wet surfaces or both instead of a tire tread design which was visually pleasing. This argument is not persuasive since it is not necessary that the prior art suggest the combination to achieve the same advantage or result discovered by applicant. Applicant has failed to cite any authority holding that a 103 rejection cannot be established if the primary reference does not address the same problem as applicant. Furthermore, applicant's argument is inconsistent the holding in In re Dillon 16 USPQ2d 1897 (Fed. Cir. 1990, cert denied, 500 US 904 (1991) (affirmance of 103 rejection wherein claimed invention addressed problem of reducing solid particles during combustion of fuel whereas applied prior art addressed problem of dewatering fuel).

Applicant argues that the shoulder treads of Lopez 652 have a width of 24.5%. Applicant is incorrect. Lopez 652 does not teach a shoulder tread having a width of 24.5%. The figures of Lopez 652 are not drawn to scale.

Applicant argues that the examiner's attempt to transmogrify the express disclosure of 22-28% into 19-26% is reaching beyond the bounds of reasonableness. Applicant's argument is not persuasive. In Hitzky, the axial width RW5 in the tire footprint has a width of 22-28% of the tread width. The axial width RW5 is not the width of the shoulder rib per se. The axial width RW5 includes the width of the shoulder rib plus one half of the groove width of the circumferential groove 4. See figure 3. In order to compare the width of Hitzky's shoulder rib to the claimed width of the shoulder rib, the half width of circumferential groove 4 must be subtracted from width RW5.

Applicant argues that Hitzky and Japan 105 contain additional teachings which cannot be ignored. See pages 13 and 14 of response filed 5-24-06. The teachings in Hitzky including those mentioned at page 13 of the response filed 5-24-06 have been considered. The teachings of Japan 105 including those mentioned at pages 14 and 15 of the response filed 5-24-06 have been considered. The combination of the teachings of Lopez 652, Hitzky and Japan 105 have been considered. When properly viewed as a whole, the applied prior art fairly suggests using a rib width of 17-19% of the tread width in Lopez 652's tread design for a tire. Hitzky and Japan 105's teachings as to shoulder rib width are applicable to Lopez 652 even though Hitzky and Lopez contain additional teachings since Lopez's tread, Hitzky's tread and Japan 105's tread have four circumferential grooves separating five land portions wherein axial width RW5 and ratio

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B:A are relevant parameters affecting the performance of the tire. The shoulder rib width in the tire footprint is independent of the features described by applicant as pages 13-15 of the response filed 5-24-06. In Hitzky, the axial width RW5 affects the width and therefore the stiffness of the shoulder rib-like land portion, which thereby affects handling. See col. 5 lines 30-34. In Japan 105, the ratio B:A affects the axial width of the shoulder rib and is a relevant parameter to tire performance including maneuvering stability. See abstract of Japan 105. Motivated by the desire found in Lopez 652 to use the illustrated design for a tread of a tire, one of ordinary skill in the art having the guidance from Hitzky and Japan 105 (also having five lands separated by four circumferential grooves) would have found it obvious to use a shoulder rib width of 17-19% tread width instead of some other shoulder rib width such as 5% tread width or 30% tread width so as to obtain desired tire performance (handling / stability).

#### **Allowable Subject Matter**

7) **Claim 28 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.**

#### **Remarks**

8) Applicant's arguments filed 5-24-06 have been fully considered but they are not persuasive. Applicant's arguments are addressed above.

9) **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).



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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10) Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven D. Maki whose telephone number is (571) 272-1221. The examiner can normally be reached on Mon. - Fri. 8:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on (571) 272-1226. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Steven D. Maki  
August 7, 2006

  
STEVEN D. MAKI  
PRIMARY EXAMINER  
8-7-06